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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/441,987	11/17/1999	MARK ALAN BURAZIN	13,497.2	-5262

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KIMBERLY-CLARK WORLDWIDE, INC.  
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17  
EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 05/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/441,987

Applicant(s)

BURAZIN ET AL.

Examiner

Alicia Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 and 48-69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 48-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **RESPONSE TO AMENDMENT**

1. In view of the Appeal Brief filed on March 13, 2003, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

## ***WITHDRAWN REJECTIONS***

2. The 35 U.S.C. §102 or §103 rejection of claims 1-22 as anticipated or obvious over Wendt et al. (5,672,248) of record in paper #5, pages 4-5, paragraph #8 have been withdrawn.

3. The 35 U.S.C. §102 or §103 rejection of claims 48-69 as anticipated or obvious over Wendt et al. (5,672,248) of record in paper #7, pages 3-4, paragraph #6 have been withdrawn.

## ***NEW REJECTIONS***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-6 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,077,590. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both claim similar tissue rolls.

Archer discloses a high bulk paper towels comprising a roll of tissue with a roll bulk of from about 14 cc/g to about 20 cc/g (col. 1, lines 59-63) and a roll firmness from about 6 to about 10 mm (col. 64-67).

7. Claims 1-22 and 48-69 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,077,590 in view of Wendt et al. (5,672,248).

Wendt et al. discloses a creped or uncreped (col. 2, lines 23-27) throughdried tissue sheets with a bulk of about 13 to about 20 cubic centimeters per gram, where the bulk is defined as the caliper of a single ply of product divided by its basis weight (col.3, lines 39-41).

Furthermore, such tissue sheets having a basis weight in the range from about 10 to about 70

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grams per square meter (col. 3, lines 51-53), which makes a single sheet caliper about 0.013 to about 0.14 centimeters (which is approximately 0.005 to 0.05 inches). The tissue also having a geometric mean modules (geometric mean slope)/geometric mean tensile strength of less than 5 (figure 6, col. 10, lines 27-46), which is the geometric mean stiffness defined as the geometric mean slope divided by the geometric tensile strength. Plus, the tissue sheets have an absorbent capacity of about 11 grams of water per gram of fiber or greater (col. 3-4, lines 66-2).

Since, the absorbent rate of the tissue is determined by basically the same procedure as the absorbent capacity (see specification page 6, lines 26-30) and Wendt discloses the same method of determining the absorbent capacity with similar results and almost all of the applicants' claimed features, the limitation of the "absorbent rate of about 4 seconds or less" is considered to be an inherent property.

Wendt discloses all the limitations of the instant claimed invention except for the tissue in roll form with the claimed roll bulk, roll firmness, roll bulk/roll firmness ratio or the roll bulk/roll firmness ratio/single sheet caliper ratio.

Archer discloses process of embossing and winding a tissue into a roll to obtain a roll bulk of from about 14 cc/g to about 20 cc/g (col. 1, lines 59-63) and a roll firmness from about 6 to about 10 mm (col. 64-67) (summary of the invention). This would produce a roll bulk/roll firmness ratio of about 20-25 cm<sup>2</sup>/g. Archer's process is aimed at increasing the bulk and strength of the final product (col. 1, lines 5-25).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the process of Archer on the tissue of Wendt because it would increase the bulk and strength of the tissue for use in household products.

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Furthermore, the combination of Archer and Wendt would yield a roll bulk/roll firmness ratio/single sheet caliper ratio of about 142 to 1795 cm/g.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Archer et al. (6,077,590).

Archer discloses a high bulk paper towels comprising a roll of tissue with a roll bulk of from about 14 cc/g to about 20 cc/g (col. 1, lines 59-63) and a roll firmness from about 6 to about 10 mm (col. 64-67).

***Claim Rejections - 35 USC § 103***

10. Claims 7-22 and 63-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wendt et al. (5,672,248) in view of Brown et al. (5,693,403).

Wendt et al. discloses a creped or uncreped (col. 2, lines 23-27) throughdried tissue sheets with a bulk of about 13 to about 20 cubic centimeters per gram, where the bulk is defined as the caliper of a single ply of product divided by its basis weight (col. 3, lines 39-41). Furthermore, such tissue sheets having a basis weight in the range from about 10 to about 70 grams per square meter (col. 3, lines 51-53), which makes a single sheet caliper about 0.013 to about 0.14 centimeters (which is approximately 0.005 to 0.05 inches). The tissue also having a geometric mean modules (geometric mean slope)/geometric mean tensile strength of less than 5 (figure 6, col. 10, lines 27-46), which is the geometric mean stiffness, defined as the geometric mean slope divided by the geometric tensile strength. Plus, the tissue sheets have an absorbent capacity of about 11 grams of water per gram of fiber or greater (col. 3-4, lines 66-2).

Since, the absorbent rate of the tissue is determined by basically the same procedure as the absorbent capacity (see specification page 6, lines 26-30) and Wendt discloses the same method of determining the absorbent capacity with similar results and almost all of the applicants' claimed features, the limitation of the "absorbent rate of about 4 seconds or less" is considered to be an inherent property.

Wendt discloses all the limitations of the instant claimed invention except for the tissue in roll form with the claimed roll bulk/roll firmness ratio or the roll bulk/roll firmness ratio/single sheet caliper ratio.

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Brown discloses a method of winding and embossing a sheet of tissue into a roll to impart a roll bulk of about 6 to 10 cubic centimeters per gram (col. 3, lines 6-10) and a roll firmness of about 0.115 to 0.150 inch (0.2921 to 0.381 cm) (col. 6, lines 4-6), see the summary of the invention. This produces a roll bulk/roll firmness ratio of about 15.7 to 34.2 cm<sup>2</sup>/g. This process allows a roll of tissues to have a high sheet count yet retain a lavishly decorated embossment (col. 1, lines 4-19).

Brown further discloses tissue sheets, which particularly benefit from the method of this invention are premium quality tissue sheets which have a relatively high degree of resiliency and low stiffness, such as throughdried tissue sheets which can be creped or uncreped (col. 2, lines 46-57).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the winding process of Brown on the tissue of Wendt because of the ability to have a high sheet count in the roll yet still maintain a decorative embossment for use in household products.

Furthermore, the combination of Brown and Wendt would yield a roll bulk/roll firmness ratio/single sheet caliper ratio of about 187 to 1580 cm/g.

11. Claims 1-22 and 48-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wendt et al. (5,672,248) in view of Archer et al. (6,077,590).

Wendt et al. discloses a creped or uncreped (col. 2, lines 23-27) throughdried tissue sheets with a bulk of about 13 to about 20 cubic centimeters per gram, where the bulk is defined as the caliper of a single ply of product divided by its basis weight (col.3, lines 39-41).

Furthermore, such tissue sheets having a basis weight in the range from about 10 to about 70 grams per square meter (col. 3, lines 51-53), which makes a single sheet caliper about 0.013 to



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about 0.14 centimeters (which is approximately 0.005 to 0.05 inches). The tissue also having a geometric mean modules (geometric mean slope)/geometric mean tensile strength of less than 5 (figure 6, col. 10, lines 27-46), which is the geometric mean stiffness defined as the geometric mean slope divided by the geometric tensile strength. Plus, the tissue sheets have an absorbent capacity of about 11 grams of water per gram of fiber or greater (col. 3-4, lines 66-2).

Since, the absorbent rate of the tissue is determined by basically the same procedure as the absorbent capacity (see specification page 6, lines 26-30) and Wendt discloses the same method of determining the absorbent capacity with similar results and almost all of the applicants' claimed features, the limitation of the "absorbent rate of about 4 seconds or less" is considered to be an inherent property.

Wendt discloses all the limitations of the instant claimed invention except for the tissue in roll form with the claimed roll bulk, roll firmness, roll bulk/roll firmness ratio or the roll bulk/roll firmness ratio/single sheet caliper ratio.

Archer discloses process of embossing and winding a tissue into a roll to obtain a roll bulk of from about 14 cc/g to about 20 cc/g (col. 1, lines 59-63) and a roll firmness from about 6 to about 10 mm (col. 64-67) (summary of the invention). This would produce a roll bulk/roll firmness ratio of about 20-25 cm<sup>2</sup>/g. Archer's process is aimed at increasing the bulk and strength of the final product (col. 1, lines 5-25).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the process of Archer on the tissue of Wendt because it would increase the bulk and strength of the tissue for use in household products.

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Furthermore, the combination of Archer and Wendt would yield a roll bulk/roll firmness ratio/single sheet caliper ratio of about 142 to 1795 cm/g.

***ANSWERS TO APPLICANT'S ARGUMENTS***

12. Applicant's arguments filed in paper #15 regarding the 35 U.S.C. 102/103 rejections of record have been considered but are moot since the rejections have been withdrawn and in view of the new grounds of rejections.

***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (703) 308-4251. The fax phone number for the organization official non-final papers is (703) 872-9310. The fax number for after final papers is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac

5/21/03

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER

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